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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/713,416	11/14/2003	Stephen Venditti	I0306.70000US00/SJH	2730
7590 Steven J. Henry Wolf, Greenfield & Sacks, P.C. 600 Atlantic Avenue Boston, MA 02210			EXAMINER LEROUX, ETIENNE PIERRE	
			ART UNIT 2161	PAPER NUMBER
			MAIL DATE 11/26/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/713,416	<b>Applicant(s)</b> VENDITTI ET AL.	
	<b>Examiner</b> Etienne P. LeRoux	<b>Art Unit</b> 2161	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 November 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-54 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-54 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

*Claim Status*

Claims 1-54 are pending. Claims 1-54 are rejected as detailed below.

*Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1, 17, 33 and 46-54 are rejected under 35 U.S.C. 102(a) as being anticipated by Pub No US 2003/0046281 (Son), hereafter Son.

Claims 1, 17, 33 and 46-54:

Son discloses:

(A) executing a search query on the data collection to produce at least one search result, the search query specifying at least one criterion, each of the at least one search results representing a resource which satisfies the at least one criterion [paragraph 101]

(B) after executing the search query, providing an input mechanism by means of which a user may select from among the search results, for preservation at least one resource represented by a search result [paragraph 101]

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(C) executing, in response to the user's selection, a command to preserve the selected at least one resource in a system location [paragraph 101]

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-16, 18-32 and 34-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Son and further in view of US Pat No 5,222,234 (Wang), hereafter Wang.

Claims 2, 18 and 34:

Son discloses the elements of the claimed invention as noted above but does not disclose wherein the system location comprises a folder. Wang discloses wherein the system location comprises a folder [col 3, line 64 through col 4, line 5]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Son to include wherein the system location comprises a folder as taught by Wang for the purpose of saving similar content in an easily accessible memory location.

Claims 3, 19 and 35:

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The combination of Son and Wang discloses the elements of the claimed invention as noted above and furthermore, discloses wherein the folder is created based on input provided by the user [Wang, col 3, line 64 through col 4, line 5]

Claims 4, 20 and 36:

The combination of Son and Wang discloses the elements of the claimed invention as noted above and furthermore, discloses wherein the folder is implemented via an indication stored in at least one persistent data store [Wang, col 3, lines 48-63].

Claims 5, 21 and 37:

The combination of Son and Wang discloses the elements of the claimed invention as noted above and furthermore, discloses wherein the act (A) further comprises each of the at least one search results representing a resource by providing an identifier which facilitates access to the resource [Wang, col 5, lines 1-10].

Claims 6, 22 and 38:

The combination of Son and Wang discloses the elements of the claimed invention as noted above and furthermore, discloses wherein the act (C) further comprises exporting the preserved resource [Wang, retrieve documents, col 2, lines 50-55]

Claims 7, 23 and 39:

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The combination of Son and Wang discloses the elements of the claimed invention as noted above and furthermore, discloses wherein the act (C) further comprises exporting the preserved resource to at least one of a CD-ROM or a paper copy [Wang, col 6, lines 30-40].

Claims 8, 24 and 40:

The combination of Son and Wang discloses the elements of the claimed invention as noted above and furthermore, discloses wherein the act (C) is performed in at least one of a manual and semi-automated manner [Wang, col 3, lines 48-58]

Claims 9, 25 and 41-43:

The combination of Son and Wang discloses the elements of the claimed invention as noted above and furthermore, discloses wherein the act (C) further comprises copying the selected at least one resource from the system location to a second system location [Wang, col 3, lines 48-58]

Claims 10 and 26:

The combination of Son and Wang discloses the elements of the claimed invention as noted above and furthermore, discloses wherein the act (C) is performed in response to a command provided by a user [Wang, col 3, lines 48-58]

Claims 11 and 27:

The combination of Son and Wang discloses the elements of the claimed invention as noted above and furthermore, discloses wherein the act (C) is performed by creating a

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relationship in at least one persistent data store between each of the selected at least one resources and the second system location [Wang, document relation object 42, Fig 2]

Claims 12 and 28:

The combination of Son and Wang discloses the elements of the claimed invention as noted above and furthermore, discloses wherein the act (C) further comprises moving the selected at least one resource from the system location to a second system location [Wang, col 3, lines 47-57]

Claims 13 and 29:

The combination of Son and Wang discloses the elements of the claimed invention as noted above and furthermore, discloses wherein the act (C) is performed in response to receiving a command provided by a user [Wang, col 3, lines 47-57]

Claims 14 and 30,

The combination of Son and Wang discloses the elements of the claimed invention as noted above and furthermore, discloses wherein the act (C) is performed by creating a relationship in at least one persistent data store between each of the selected at least one resources and the second system location [Wang, col 3, lines 47-57].

Claims 15, 31 and 44:

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The combination of Son and Wang discloses the elements of the claimed invention as noted above and furthermore, discloses wherein the user is a human operator [Wang, col 3, lines 47-57]

Claims 16, 32 and 45:

The combination of Son and Wang discloses the elements of the claimed invention as noted above and furthermore, discloses wherein the at least one criterion is provided by the user [Wang, col 3, lines 47-57].

***Response to Arguments***

Applicant's arguments filed 11/2/2007 have been carefully considered but they are not persuasive for the reasons given below.

**Applicant Argues:**

Applicant states in the second paragraph of page 14 "Applicant respectfully traverses the rejection of claims 1, 17, 33 and 46-54 since Son fails to teach each and every element of these claims. For example, Son does not disclose at least the following elements found in claim 1:

**providing an input mechanism by means of which a user may select from at least one search result for preservation at least one resource identified in the at least one search result."**



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**Examiner Responds:**

Examiner is not persuaded. Son discloses the following in paragraph 101:

[101] In the example used to illustrate the embodiment, the user selects content directly from the search results included in the referenced search history of a registrant and issues a request to get the content. It is also possible that the user references the search history of a registrant and attempts a further search through history records, modifying the search criteria and, based on the result of the further search, the user issues a request for content. In such a case, it is determined whether or not the user relied on the first search history when selecting content by comparing the of search results returned by the search subsequent to accessing of the first search history with the results included in the first search history (how many corresponding search results are included) or by comparing search criteria returned by the later search to those included in the first search history (how many corresponding keywords are included). Specifically, if a certain percentage of corresponding search results or search criteria are included, the intermediate server determines that the first search history was used when content was selected and therefore executes the step of rewarding the registrant of the first search history.

The claim limitation **“select from the at least one search result for preservation”** can be mapped to “intermediate server determines that the first search history was used when content was selected” as included in paragraph 101.

Furthermore, Son includes in paragraph 90, the following:

In example of the present embodiment, “Delete” links are attached to the items of search history as shown as shown in FIG. 9. Using these links, search histories that regarded as inappropriate can be deleted by a user who has chosen to have such search histories deleted by default.

The claim limitation **“select from the at least one search result for preservation”** can be mapped to above “search histories regarded as inappropriate can be deleted by a user” as included in paragraph 90.

Furthermore, Son includes the following in paragraph 94:

When the user selects desired content out of his or her search results presented on the window shown in FIG. 10 and issues a request for retrieval of the content (S7) the intermediate server 3 sends to the central server 1 a request for retrieval of the content on behalf of the user (S8).

The claim limitation “**a user may select from at least one search result**” can be mapped to above “when the user selects desired content out of his or her search results presented on the window” as included in above paragraph 94.

**Applicant Argues:**

Applicant states Son does not disclose the claim language “**executing in response to the user’s selection, a command to preserve the content of the selected at least one resource in a system location.**”

**Examiner Responds:**

Examiner is not persuaded. Son discloses the limitation *a command to preserve the content* as below:

(1) paragraph 101 includes:

the intermediate server determines that the first search history was used when content was selected and therefore executes the step of rewarding the registrant of the first search history

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Examiner maintains that the claimed *command* is inherent in the above disclosure of Son because Son does not disclose that the saving is automatically determined such as by artificial intelligence.

(2) paragraph 58 includes:

When the intermediate server presents search results to the user, the user is asked whether or not the search results should be recorded as search history.

Examiner maintains that the claimed *command* is inherent in the above disclosure of Son because the user responds to the question and this user response can be interpreted as a command.

(3) paragraph 60 includes:

In this preferred embodiment, after executing a search, the intermediate server prompts the user to input comments which are recorded as a part of the history record of the search. This step is intended to collect information reflecting the actual circumstances of user search request activity.

Examiner maintains that the claimed *command* is inherent in the above disclosure of Son because the server prompts the user to input comments which are recorded as part of the search history.

**Applicant Argues:**

Applicant states in the second paragraph of page 14 "However, nowhere in Son paragraph 101, or elsewhere is Son, is there a suggestion of *selecting at least one resource to be preserved* as recited in claim 1.

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**Examiner Responds:**

Examiner is not persuaded. The claim language is required to be interpreted in light of the specification. The abstract of instant application states:

Methods and apparatus are provided for preserving electronic resources identified as search results in a system location, such as a system folder. In one embodiment, a computer-implemented method comprises executing a search query on a data collection to produce at least one search result, the search query specifying at least one criterion, each of the at least one search results representing a resource which satisfies the at least one criterion; providing an input mechanism by means of which a user may select at least one resource for preservation; and executing, in response to the user's selection, a command to preserve the selected at least one resource in a system location.

Examiner interprets resources as search results. Son discloses a plurality of search results.

**Applicant Argues:**

Applicant states in the fourth paragraph of page 15 “Moreover, in formulating a rejection under 35 U.S.C. § 103 (a) based upon a combination of prior art elements, it remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed.”

**Examiner Responds:**

Examiner is not persuaded. The reason for combination is clearly stated in above Office action.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Etienne P. LeRoux whose telephone number is (571) 272-4022. The examiner can normally be reached Monday through Friday between 8:00 am and 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Apu Mofiz can be reached on (571) 272-4080. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Etienne LeRoux

11/21/2007

A handwritten signature in black ink, reading "Etienne LeRoux". The signature is written in a cursive, flowing style.

ETIENNE LEROUX  
PRIMARY EXAMINER